

REMARKS

As specified under 37 C.F.R. §1.291, the Protestor respectfully protests the patent application filed November 10, 1999, having a serial number 09/437,378. To the best of the Protestor's knowledge, no Notice of Allowance has been mailed in the above-cited application and the Protestor respectfully asserts that this Protest complies with 37 C.F.R. §1.291 and should be considered.

The Protestor respectfully asserts that no claim should be allowed in the above-cited application and that the application should not be allowed to proceed to issue, in view of the discussion below and the documents cited herein and listed on the attached PTO-1449. The Protestor presents several documents that would be considered prior art under 35 U.S.C. §102(a), (e) and (f) that the Protestor respectfully asserts should preclude the patentability of claims pending in the above-cited application and preclude the patentability of any claims that could be formed based on the disclosure of the specification of the above-cited application.

The Protestor has also enclosed a Glossary of terms used in the above-cited application with definitions to aid the Examiner. Many of the terms used in the above-cited application are not the terms used commonly in the art to which the application is directed. The Glossary provides commonly used definitions and synonyms for those terms to aid in any search by the Examiner of the prior art.

The Protestor respectfully directs the Examiner's attention to the enclosed Declaration from Herbert Van de Sompel. The Declaration traces the development of Dr. Van de Sompel's invention of the SFX linking system that establishes links between

online resources. The References AC through AI, listed in the attached PTO FORM 1449, all support the facts provided in the Declaration, where a majority of those references disclose all of the elements disclosed in the above-cited application and may be applied under 35 U.S.C. §102(a) or §102(b). The Examiner is respectfully requested to review the individual references to determine their specific applicability to the claims as they are presently formulated.

The enclosed declaration also provides evidence that should be applied under 35 U.S.C. §102(f) that the listed inventors for the above-cited application did not actually invent the subject matter for which they disclose and claim. The Declaration contains attachments thereto and the Protestor directs the Examiner's attention to the email correspondence between one of the inventors of the above-cited application, Eric Hellman, and Dr. Van de Sompel. Mr. Hellman discusses the proper ownership of a patent that might issue from the above-cited application, and suggests that Mr. Hellman considered Dr. Van de Sompel as at least a co-inventor of the above-cited application. The nature of the invention is clear from the print-out of the disclosure document, which was an attachment to Mr. Hellman's email of June 28, 1999. As provided in the Declaration, Dr. Van de Sompel decided not to seek patent protection with Mr. Hellman. Given that the above-cited application was filed without naming Dr. Van de Sompel as a co-inventor, the Declaration may be used to show that the claims of the present invention are not patentable since the listed inventors did not themselves invent the subject matter sought to be patented.

In addition, Reference AJ, Priscilla Caplan et al. from D-Lib Magazine, discloses the field of reference linking. Page 2, second paragraph, discloses the “appropriate copy” problem and the requirement for systems to be capable of supporting resolution to multiple items, at page 6, third paragraph and dynamic linking, at page 7, second paragraph, referencing the work of Herbert Van de Sompel. The reference also details how identifiers are resolved, where that description covers many areas disclosed in the above-cited application. Given the reference’s publication date of July/August 1999, the reference may be applied under 35 U.S.C. §102(a) and discloses many elements claimed in the above-cited application.

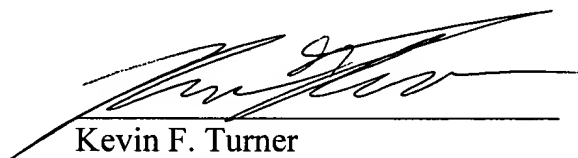
Additionally, Reference AK, Priscilla Caplan et al. from the Digital Library Federation Architecture Committee, also discloses the use of a hot-linked resolution service, page 4, to provide redirection by a resolution service to a specific location for the desired item so that the “appropriate copy” problem may be solved. Given the reference’s publication date of September 1999, the reference may be applied under 35 U.S.C. §102(a) and discloses many elements claimed in the above-cited application.

Lastly, the Protestor wishes to draw the Examiner’s attention to U.S. Patent Nos. 6,009,410 and 6,141,010, to LeMole et al. and Hoyle, respectively, where customized advertising is provided to a user through the Internet. It may be alleged that none of the proceeding documents seem to specifically disclose performing advertising through a hyperlink redirection facility, as disclosed in the above-cited application. However, the Protestor respectfully asserts that given the disclosures of the cited U.S. patents, the embodiments directed to performing advertising through a hyperlink redirection facility

would be obvious in view of the disclosure of the previously discussed references and evidence. U.S. Patent Nos. 6,009,410 and 6,141,010 may be applied under 35 U.S.C. §102(e).

If for any reason the Examiner determines that further clarification of any subject matter contained in this Protest is needed, it is respectfully requested that the Examiner contact, by telephone, the protestor's undersigned attorney at the indicated telephone number to expedite consideration of this Protest.

Respectfully submitted,



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Enclosures: Declaration by Herbert Van de Sompel
PTO-1449 List of References Cited (with 12 documents)
Glossary of Terms used in above-cited application